

App'n. Serial No. 10/721,895
Filed: November 26, 2003
Docket No.: 8932-803-999
CAM No.: 232200-999210

Amendments to the Drawings:

The attached drawing sheets include an amendment to FIG. 1 and a new FIG. 5. The first sheet includes FIGS. 1 and 2 and replaces the original sheet that included FIGS. 1 and 2. In FIG. 1, a new "section" line, labeled "V-V," has been added. The second drawing sheet includes new FIG. 5, and depicts a cross-section through the bone plate along line V-V, shown in amended FIG. 1. The attached APPENDIX includes a clean replacement Sheet containing FIGS 1 and 2, a clean new sheet with FIG. 5, and an annotated copy of the sheet containing FIG. 1, showing changes.

Attachments: Replacement Sheet (1 page)
New Sheet (1 page)
Annotated Sheet Showing Changes to FIG. 1 on Replacement Sheet (1 page)

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REMARKS

This amendment is submitted in response to the non-final Office Action mailed November 29, 2005. Following entry of this amendment, claims 1-46 will be pending in the application. In the Office Action, the Examiner:

- objected to the drawings under 37 C.F.R. § 1.83(a) as not showing the claimed "double threaded" hole;
- rejected claims 5 and 34 under 35 U.S.C. § 112 as indefinite in using the term "double threaded";
- rejected pending claims 1, 2, 6, 7, 10-12, 18, 19, 21-25, 28, 29, 32, 36 and 39 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,623,486 to Weaver et al. (hereinafter "Weaver");
- rejected pending claims 3, 4, 8, 9, 13-17, 20, 26, 27, 30, 31, 33, 35, 37, and 38 under 35 U.S.C. § 103(a) as obvious in view of Weaver and the knowledge of one of ordinary skill in the art; and
- rejected pending claims 5 and 34 under 35 U.S.C. § 103(a) as obvious in view of Weaver in combination with U.S. Patent No. 6,572,622 to Schafer et al. (hereinafter "Shafer").

Applicants have amended the drawings and specification to remedy the drawing objections and Section 112 claim rejections. Applicants have also amended claims 1, 8, 21 and 26, and added new claims 40-46, to further define the present invention, correct minor errors and/or more clearly distinguish over the cited prior art. All amended drawings, specification paragraphs, and claims are fully supported by the originally-filed specification and/or drawings of the present application. No new matter has been added. The claim amendments made herein do not represent acquiescence in the Examiner's rejections, but rather are made only to expedite prosecution of the present application. Applicants expressly reserve the right to pursue the subject matter of any previously presented claims in one or more continuation applications. As discussed more fully below, Applicants respectfully submit that each of the currently pending claims define features of the present invention that are not disclosed, taught or suggested by the prior art of record and respectfully requests allowance of same.

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Drawings

The Examiner has objected to the drawings as not showing the "double threaded" hole recited in claims 5 and 34. (Nov. 29, 2005 Office Action in Appln. Ser. No. 10/721,895 at 2 (hereinafter, "the Office Action").) In response, Applicants have added new FIG. 5, which is a partial cross-section taken through the bone plate shown in FIG. 1, to more clearly show the recited double threaded hole. Applicants have also amended FIG. 1 to include a new section line "V-V," which corresponds to the cross-section shown in FIG. 5. These drawing changes are fully supported by the originally-filed specification. No new matter has been added. Applicants respectfully request approval of amended FIG. 1 and new FIG. 5, and submit that these drawing changes obviate the objections to the drawings.

An Appendix containing a replacement drawing sheet (with FIGS. 1 and 2), a new drawing sheet (FIG. 5), and an annotated drawing sheet showing changes to amended FIG. 1 is attached.

Specification

Applicants have also amended the specification to include reference to new FIG. 5, which shows the claimed "double threaded" hole. Moreover, Applicants respectfully submit that "double threaded" holes and screws (also referred to as "double lead threads") are well-known in the art, and permit multiple threads to engage a fixation element, e.g., a screw. Applicants respectfully submit that the reference to "multithreaded" and/or "double threaded" holes in the specification and claims of the originally-filed specification (Specification at page 8, lines 14-16, 21-23) provides support for these amendments. No new matter has been added. Accordingly, applicants respectfully request entry of these amendments.

Claim Rejections - 35 U.S.C. § 112 ¶ 2

Claims 5 and 34 were rejected under 35 U.S.C. § 112 as indefinite in reciting a "double threaded" hole. (Office Action at 3.) The Office Action states that "[t]he term double threaded is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonable apprised of the scope of the invention." (*Id.*) Applicants respectfully traverse this claim rejection. First, as discussed above, double lead threads are well-known in the art, and applicants submit that a person of ordinary skill in the art would understand the reference in

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the Specification of the present application to "multithreaded" and "double threaded" holes as a clear reference to a hole with a multiple lead thread. Second, as discussed above, applicants have amended the specification and drawings to describe and show the recited "double threaded" hole. Accordingly, applicants submit that claims 5 and 34 are not indefinite because a person of ordinary skill in the art would understand the scope of the term "double threaded," as described and shown in the amended specification and drawings. Applicants respectfully request withdrawal of the indefiniteness rejections of claims 5 and 34.

Claim Rejections - 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a)

Claims 1, 2, 6, 7, 10-12, 18, 19, 21-25, 28, 29, 32, 36 and 39 were rejected as anticipated under 35 U.S.C. § 102(e) by Weaver. The Office Action also states that the limitations of claims 3, 4, 8, 9, 13-17, 20, 26, 27, 30, 31, 33, 35, 37, and 38 are *not* disclosed by Weaver, but that "[i]t would have been *obvious* to one having ordinary skill in the art at the time the invention was made to construct the bone plate of Weaver having the [claimed] ranges." Applicants respectfully traverse these claim rejections and submit that amended claim 1, original independent claim 25, and new independent claim 43 are all allowable over the prior art of record.

Claims 1-24 and 40-46

First, applicants submit that the obviousness rejection of claims 3, 4, 8, 9, 13-17, 20, 26, 27, 30, 31, 33, 35, 37, and 38 should be withdrawn because, pursuant to 35 U.S.C. § 103(c), Weaver is disqualified as prior art used in an obviousness rejection.¹ In support of this statement, and pursuant to MPEP 706.02(I)(2)(II) applicant, by and through its attorneys, respectfully submits that:

Weaver and the present application were, at the time the invention of the present application was made, owned by, or subject to an obligation of assignment to, Synthes (U.S.A.).

Applicants further submit that the assignment records demonstrating that the present application and Weaver are commonly owned by Synthes (U.S.A.) have been recorded with the Patent Office at Reel 015266, Frame 0654, and Reel 011364, Frame 0057, respectively. Consequently, Applicants respectfully submit that the obviousness rejection of

¹ As noted in the Office Action, Weaver only qualifies as prior art to the present application under 35 U.S.C. § 102(e) because Weaver was first published on Sept. 23, 2003, after the May 28, 2001 priority date of the present application. (Office Action at 4.)

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claims 3, 4, 8, 9, 13-17, 20, 26, 27, 30, 31, 33, 35, 37, and 38 should be withdrawn because Weaver is not available as prior art in this context.

Since dependent claims 3 and 8 are patentable over the prior art of record, applicants have amended claim 1 to include the limitations of claim 8, and have added new independent claim 43, which is effectively original claim 3 rewritten in independent form. Applicants respectfully request allowance of amended claim 1, and its dependent claims 1-24, and 40-42, and new independent claim 43, and its dependent claims 44-46.

Claims 25-39

Independent claim 25 recites a bone plate comprising, *inter alia*, an elongated shaft portion and a widened head portion, the shaft portion and the head portion defining a common longitudinal axis extending substantially centrally along the bone plate; a first pair of screw holes located in the head portion, the first pair of holes include a first hole having a first central axis and a second hole having a second central axis, wherein the first and second holes are asymmetrically disposed about the longitudinal axis; and a second pair of screw holes located in the head portion, the second pair of holes include a third hole having a third central axis and a fourth hole having a fourth central axis, wherein the third and fourth holes are symmetrically disposed about the longitudinal axis.

The Office Action cites Weaver as disclosing the claimed "head portion" having third and fourth holes symmetrically disposed about the longitudinal axis of the bone plate. (Office Action at 4.) Applicants respectfully submit that Weaver does not disclose a bone plate having, *inter alia*, a head portion with third and fourth holes symmetrically disposed about the longitudinal axis, as recited in claim 25. More particularly, as shown in FIG. 7 of Weaver as reproduced in the Office Action, there are no pairs of holes in what is cited by the Examiner as the "head portion" of the Weaver bone plate that are symmetrically disposed about the longitudinal axis. As shown in Weaver's FIG. 7, the head holes of Weaver are all asymmetrically disposed about the longitudinal axis of the bone plate. Consequently, Weaver does not disclose all of the elements of independent claim 25, and applicants respectfully request that the anticipation rejection of claim 25 be withdrawn and that claim 25, and each of its dependent claims 26-39, be allowed.

In view of the above amendments and remarks, Applicants respectfully request that the Examiner reconsider pending claims 1-46 with a view towards allowance.

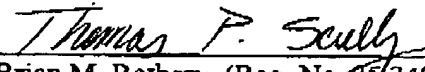
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The Examiner is invited to call the undersigned attorney at (212) 326-3939 if a telephone call could help resolve any remaining issues.

A separate Amendment Fee Sheet for additional claim fees is submitted herewith. Should any additional fees be required, please charge such fees to Jones Day deposit account no. 50-3013.

Respectfully submitted,

Date: Febrary 28, 2006



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APPENDIX

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Amendment Dated Feb. 28, 2006
Reply to Nov. 28, 2005 Office Action
Annotated Drawing Sheet Showing Changes

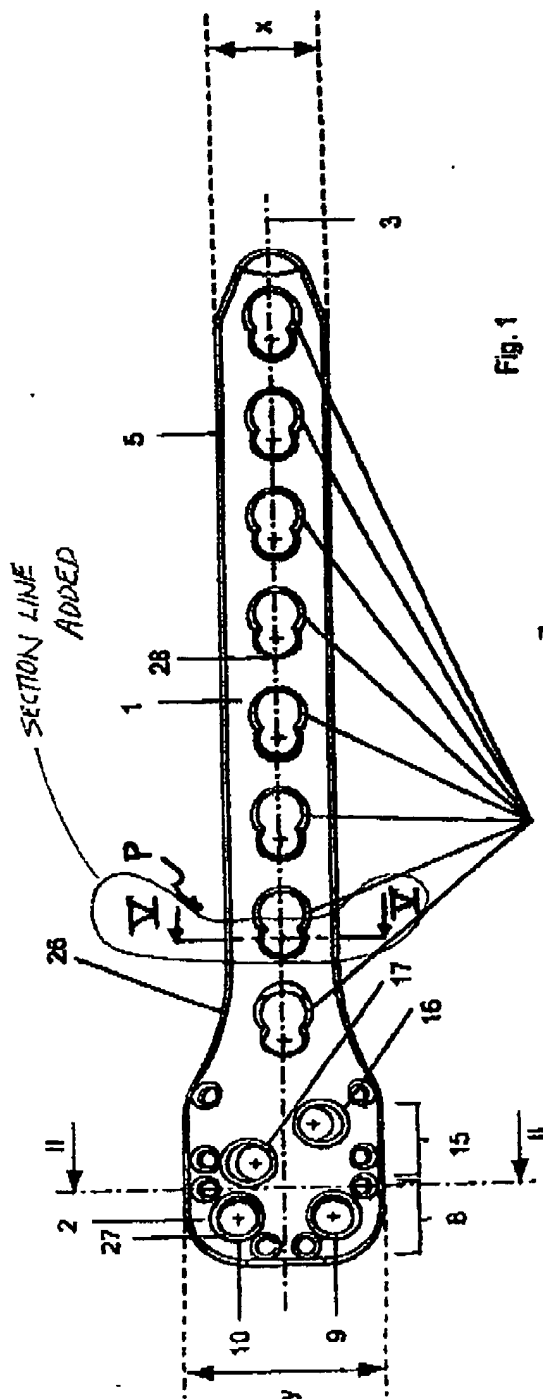


Fig. 1

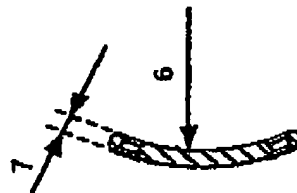


Fig. 2